Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte BRIAN GALLAGHER, WAYNE W. DUSO,
and WILLIAM J. LEARY, JR.

_____

Appeal No. 2001-0164
Application No. 08/885,379

_____

ON BRIEF

_____

Before FLEMING, RUGGIERO, and LALL, ***Administrative Patent Judges***.

FLEMING, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-9.

The invention relates to a method for booting operating system software into a main memory of a central processing unit (CPU). The method includes executing a program (401) to sequentially search possible sources of the operating system

during a boot-up phase and when a possible source of the operating system is detected, having the CPU (80) check to determine whether such detected source is operational and has a valid boot format (402). See Appellants' specification on page 38, lines 1-11 and 25-32 and associated Figure 16. If the detected source is operational and has a valid boot format (403), the method includes the step of having the CPU boot the detected operating system into the main memory (404). See Appellants' specification on page 39, lines 2-6 and associated Figure 16. If the detected source is either non-operational or does not have a valid boot format, the method includes the step of having the CPU check another one of the possible operating system sources (405). See Appellants' specification on page 39, lines 6-10 and associated Figure 16. If all sources are checked and none are both operational and have a valid boot format, the method includes the step of having the CPU repeat the aforementioned sequential search of the possible operating system sources. See Appellants' specification on page 38, lines 19-22, page 39, lines 31-33 and associated Figure 16.

The only independent claim 1 present in the application is reproduced as follows:

A method for booting operating system software into a main memory of a CPU, comprising the steps of:

executing a program to sequentially search a plurality of possible sources of the operating system during a boot-up phase;

when a possible source of the operating system is detected, having the CPU check to determine whether such detected source is operational and has a valid boot format;

if the detected source is operational and has a valid boot format, having the CPU boot the detected operating system source into the main memory;

if the detected source is either non-operational or does not have a valid boot format, having the CPU check another one of the possible operating system sources;

if all sources are checked and none are both operational and has a valid boot format, having the CPU repeat the aforementioned sequential search of the possible operating system sources.

References

The reference relied on by the Examiner is as follows:

Bealkowski et al. (Bealkowski)	5,210,875	May 11, 1993

Rejections at Issue

Claims 1-9 stand rejected under 35 U.S.C. § 102 as being anticipated by Bealkowski.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs[1] and the Answer for the respective details thereof.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of Appellants and Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1-9 under 35 U.S.C. § 102.

The Examiner has rejected claims 1-9 under 35 U.S.C. § 102 as being anticipated by Bealkowski. See Examiner's Answer on page 2, lines 18-19. To support the position that Bealkowski discloses the limitation, "if all sources are checked and none are both operational and has a valid boot format, having the CPU repeat the aforementioned sequential search of the possible operating system sources" in claim 1, the Examiner cites to Figure 6B and column 11, lines 38-47. See Examiner's Answer on

[1] Appellants filed an appeal brief on January 24, 2000, Paper No. 13. In response to the Examiner's Answer, Paper No. 14, mailed April 7, 2000, Appellants filed a Reply Brief on June 7, 2000, Paper No. 15. The Examiner mailed an office communication on September 6, 2000, Paper No. 16, stating that the reply brief has been considered.

page 3, lines 13-15. Appellants argue that Bealkowski does not disclose the above-recited repeat step. See Appeal Brief on page 6, lines 16-21.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.,*** 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Upon review, we find that Bealkowski does not disclose the element, "if all sources are checked and none are both operational and has a valid boot format, having the CPU repeat the aforementioned sequential search of the possible operating system sources," of claim 1. Bealkowski discloses in Figure 6A, in column 4, lines 6-7 and in column 10, lines 1-4 a method for booting operating system software into main memory of a CPU that includes the step of having the system halt if the routine is not able to load the boot record from all the sources (fixed disk or a diskette). In contrast, claim 1 recites that if all sources are checked and none are operational and have a valid boot format the CPU repeats the sequential search of the possible operating system sources.

In addition, the Examiner takes the position that the return step (214) discussed in column 11, line 47 of Bealkowski is the same as repeating "the aforementioned sequential search of the possible operating system sources" recited in claim 1. See Examiner's Answer on page 5, lines 6-12. An examination of Figure 6B, column 4, lines 8-9, and in column 11, lines 38-60 of Bealkowski demonstrates that the return step (214) is within a single source, such as the fixed disk. The sequence attempts ninety-nine times to read a boot record from the fixed disk. Each time an error occurs within an attempt the sequence returns. However, once all sources are checked and none are found to be both operational and have a valid boot format, the CPU does not "repeat the aforementioned sequential search of the possible operating system sources" as recited in claim 1. Rather, Bealkowski discloses in column 10, lines 1 through 4 that the system halts.

Thus, we find that Bealkowski does not recite the step of "if all sources are checked and none are both operational and has a valid boot format, having the CPU repeat the aforementioned search of the possible operating system sources" recited in claim 1.

We next turn to the rejections of dependent claims 2-9 also rejected under 35 U.S.C. § 102 as being anticipated by Bealkowski. Since we cannot sustain the rejection of independent claim 1, we also cannot sustain the rejection of dependent claims 2-9.

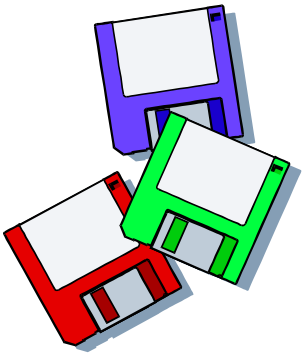
In conclusion, we reverse the rejection of claims 1-9 under 35 U.S.C. § 102.

REVERSED

MICHAEL R. FLEMING Administrative Patent Judge	)	
JOSEPH F. RUGGIERO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PARSHOTAM S. LALL Administrative Patent Judge	)	

MRF/lbg

RICHARD M SHARANSKY
FISH AND RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804



Lesley

Appeal No. 2001-0164
Application No. 08/885,379

APJ FLEMING

APJ RUGGIERO

APJ LALL

DECISION: REVERSED

Prepared: June 6, 2003

Draft Final

3 MEM. CONF. Y N

OB/HD GAU 2100

PALM / ACTS 2 / BOOK

DISK (FOIA) / REPORT